The term "same invention" under 35 U.S.C. §101 means "identical subject matter." Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In Re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA, 1970). A reliable test for double patenting is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. If there is such an embodiment, then identical subject matter is not defined by both claims and double patenting does not exist. See MPEP 804 (II)(A).

Claims 1, 3 and 5-8 of Tsai et al. each require a breathable, biodegradable laminate comprising a biodegradable nonwoven material and a filled, biodegradable film. The film must be stretched by about 100-500% of its original length. The laminate must have a water vapor transmission rate ("WVTR") greater than about 3000 grams/m^2-24 hr.

Applicants' claims require the film and laminate to be breathable, but do not require a minimum WVTR value. Applicants' claims read on embodiments in which the WVTR of the film (and, thus the laminate) are substantially less than 3000 grams/m^2-24 hrs., as well as embodiments having a higher WVTR (See specification, p. 15, middle paragraph).

Applicants' claims require the film to be stretch-thinned, but do not recite a lower or upper limit for the amount of stretching. For example, Applicants' claims cover embodiments in which the film is stretched by as little as 10%, to 1.1 times its original length, as well as embodiments where the film is stretched by 600%, to 7.0 times its original length. (Specification, p. 13, second paragraph).

For at least these reasons, the rejected claims of the instant application can be literally infringed without literally infringing the claims of the Tsai et al. patent. There is no "same invention" double patenting. The rejection under 35 U.S.C. §101 should be withdrawn.

The Examiner rejected Claims 22-26, 31, 35, 48-52 and 57-58 based on obviousness-type double patenting over Claims 1, 3 and 5-8 of U.S. Patent 6,838,403 (Tsai et al.). This rejection is respectfully traversed.

For purposes of a double patenting rejection, only the claims, and not the specification of the reference patent may be used as prior art. The disclosure of the Tsai et al. specification is not considered to be prior art. See M.P.E.P. 804 (II)(B)(1). Because

the Examiner used the specification of Tsai et al. as prior art, this rejection should be withdrawn.

Furthermore, in order to facilitate allowance of this case, Applicants have enclosed a Terminal Disclaimer which disclaims the terminal portion of the instant application extending beyond the expiration date of Tsai et al. This will overcome the double patenting rejection.

Applicants believe that the claims are in condition for allowance, and respectfully request withdrawal of the double patenting rejections.

Respectfully submitted,

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